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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,143	07/16/2002	Frank-Gunter Niemz	4197-116	9811

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INTELLECTUAL PROPERTY / TECHNOLOGY LAW
PO BOX 14329
RESEARCH TRIANGLE PARK, NC 27709

EXAMINER

DEL SOLE, JOSEPH S

ART UNIT	PAPER NUMBER
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1722

DATE MAILED: 10/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/089,143

Applicant(s)

NIEMZ ET AL.

Examiner

Joseph S. Del Sole

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 1-5, 8-10, 15 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6, 7 and 11-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/3/02 & 6/5/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 1-5, 8-10 and 15-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected method, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 9/23/04.

Applicant's election with traverse of claims 6-7 and 11-14 in the reply filed on 9/23/04 is acknowledged. The traversal is on the ground(s) that there would be a great economy of cost and effort on the part of the Office if the subject matter of both groups were examined and that the subject matter of the groups define one invention and do not possess sufficient differences to warrant issuance of separate patents. This is not found persuasive because the special technical features between the two inventions are different and thus the searches for both inventions largely don't overlap.

The requirement is still deemed proper and is therefore made FINAL.

Specification

2. The abstract of the disclosure is objected to because **a)** the abstract is over 150 words; and **b)** the abstract currently summarizes both the method and apparatus, but since only apparatus claims are examined the abstract should only summarize the apparatus. Correction is required. See MPEP § 608.01(b).

3. The disclosure is objected to because of the following informalities: **a)** the title describes both the method and the apparatus, however since only apparatus claims are elected the title should be rewritten to include only the apparatus; **b)** at page 3, line 1

"2a" should be deleted; **c)** at page 3, line 34 "solutions is to strong." should be changed to --solutions is too strong.--; and **d)** at page 4, line 17 "the invention accordinly allows" should be changed to --the invention accordingly allows--.

Appropriate correction is required.

Claim Objections

4. Claim 6 is objected to because of the following informalities: **a)** "washing bath downstream form the precipitation" at line 12 of claim 6 should be changed to --washing bath downstream from the precipitation--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 13 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 is vague and indefinite because it is unclear whether "the measuring device" further limits the device for measuring the temperature as claimed in claim 7 or the on of the other "plurality of devices for the measurement" as claimed in claim 6.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 6-7 and 11-14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7-13 of copending Application No. 10/070,624 in view of WO94/28212. Claims 7-13 of application 10/070,624 teach a device having a mixing apparatus with at least two metering elements (claim 7, lines 5-7); a dissolving and evaporation device connected to the mixing apparatus (claim 7, lines 8-9); an extrusion device connected to the dissolving and evaporation device (claim 7, lines 10-11); a precipitation bath downstream of the extrusion device and separated therefrom by an air gap (claim 7, lines 11-12); a plurality of devices for the measurement of a non-optical property and arranged to communicate with metering elements (claim 7, lines 13-15) and arranged to communicate with metering elements, the evaporator device and or return evaporator via at least one regulation circuit for the regulation of the composition of the solutions contained in the mixing apparatus, the dissolving and evaporation device and/or the precipitation bath (claim 7, lines 16-22); the measuring device further has a device for measuring the temperature of the solution and for compensating the measured values of the device according to the temperature (claim 9); the measuring device measures a measurement selected from the group consisting of a dielectric constant, inductive

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conductivity, microwave absorption, density, water content and ultrasonic speed (claim 8) and each measuring device is measuring a different property (claim 13).

Claims 7-13 of 10/070,624 fail to teach at least one washing bath downstream from the precipitation bath; a line connected between the washing bath and at least one of the metering devices, wherein the line further has a return evaporator; a return line from the washing bath connected to the precipitation bath; and a measuring device positioned between the washing bath and precipitation bath.

WO94/28212 teaches a washing bath downstream from the precipitation bath; a line connected between the washing bath and at least one of the metering devices, wherein the line further has a return evaporator; a return line from the washing bath connected to the precipitation bath; and a measuring device positioned between the washing bath and precipitation bath (Fig 3) for the purpose of controllably recycling materials used in filament processing (page 6, lines 1-10).

It would have been obvious to one having ordinary skill in the art at the time of the Applicant's invention to have modified the invention of claims 7-13 of 10/070,624 with a washing bath, return line connected to the precipitation bath and a measuring device between the washing bath and precipitation bath as taught by WO94/28212 because it provides greater control over filament production.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

References of Interest

9. Rulison et al is cited of interest to show the state of the art.

Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Joseph S. Del Sole whose telephone number is (571) 272-1130. The examiner can normally be reached on Monday through Friday from 8:30 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Benjamin Utech, can be reached at (571) 272-1137. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306 for both non-after finals and for after finals.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from the either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on the access to the Private PAIR system, contact the Electronic Business Center (EBC) at 886-217-9197 (toll-free).

Joseph S Del Sole

J.S.D.

October 19, 2004